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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/639,143	08/11/2003	Yanon Volcani	11CF-123022	7036
30764 7590 08/27/2008 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448				
EXAMINER				
VO, HUYEN X				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/639,143

Applicant(s)

VOLCANI ET AL.

Examiner

HUYEN X. VO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/28/2008 have been fully considered but they are not persuasive. The term "computer readable medium" is not part of the original disclosure. It is now considered new subject matter. Applicant is suggested to change "computer readable medium" to -- computer readable memory -- which is supported by the disclosure as ROM, RAM, memory, etc. The claims are treated as originally filed claiming a computer program.

2. With respect to applicant's argument regarding the 102(b) prior art, the effective filing date of the prior art of record is 8/11/1999 while the effective filing date of the present application is 12/21/1999. Therefore, rejection under 102(b) has now been amended to 102(e). The previous office action has been withdrawn in favor of a new non-final office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "computer readable medium" is not found in the disclosure.

Oath/Declaration

5. It does not include the notary's signature, or the notary's signature is in the wrong place.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claims 1-24 are drawn to a "program" *per se* as recited in the preamble (*the term "computer readable medium" is not found in the disclosure. The claims are interpreted as originally filed "computer program"*) and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships

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between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-10 and 14-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Chase (USPN 6332143).

11. Regarding claim 1, Chase discloses a computer program stored on a computer readable medium (*col. 6, lines 42-44*) comprising:

a vocabulary database (*database 12 in figure 2*) comprising machine readable data corresponding to a plurality of vocabulary words (*table 2 in col. 8-10*) and a lexical impact value respectively corresponding to each vocabulary word for a chosen lexical impact scale (*col. 12, lines 22-52, intensity of the words*);

comparison instructions comprising machine readable instructions for comparing a plurality of text words of a writing to the vocabulary database to determine lexical impact values for the chosen lexical impact scale for each text word that corresponds to a vocabulary word (*col. 11, line 36 to col. 12, line 67 and/or referring to figures 4-5*); and

output instructions comprising machine readable instructions for outputting the lexical impact value of the text words for the chosen lexical impact scale that correspond to vocabulary words as output data (*referring to graph in figure 5*).

12. Regarding claims 2-5 and 14, Chase further discloses the computer program of claim 1, wherein the output instructions further comprise machine readable instructions for outputting an overall lexical impact value of the text words in the writing for the chosen lexical impact scale (*referring to the values on the graph in figure 5*), wherein the overall lexical impact value is the average lexical impact value of the text words for the chosen lexical impact scale (*averaging equation in col. 12, line 25*), wherein the average lexical impact value is a per word value averaged over the entire writing (*averaging equation in col. 12, line 25; analyzing the whole document in figures 3-4*),

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wherein the average lexical impact value is a per word value averaged over a portion of the writing (*averaging equation in col. 12, line 25, depending on the setting*), and wherein the computer program is configured to operate over a website interface (*col. 6, lines 31-60; internet and website*).

13. Regarding claims 6-10, Chase further discloses the computer program of claim 3, further comprising comparison instructions including machine readable instructions for comparing the average lexical impact value for the chosen lexical impact scale to a predetermined lexical impact threshold value (*col. 22, line 50 to col. 23, line 5*), further comprising generating a visual display, perceivable by the author, indicative of exceeding a predetermined lexical impact average threshold value (*col. 22, line 50 to col. 23, line 5; the purpose is to eliminate unreliable data; only good data is used in further processing and ultimately output to the user*).

14. Regarding claim 15, Chase discloses a computer program stored on a computer readable medium (*col. 6, lines 42-44*) comprising:

a thesaurus database (*database 12 in figure 2, containing words with similar emotion*) comprising machine readable data corresponding to thesaurus groupings and rankings for each thesaurus grouping, with respect to a plurality of lexical impact scales (*table 2 in col. 8-10*);

input instructions comprising machine readable instructions for receiving a requested text portion for a chosen lexical impact scale (*text of figure 3 is input into the*

system for analysis; or referring to col. 11, line 36 to col. 12, line 67 and/or referring to figures 4-5);

retrieval instructions comprising machine readable instructions for retrieving a thesaurus grouping corresponding to the requested text portion (*col. 9, lines 28-40*); and

output instructions comprising machine readable instructions for outputting the thesaurus grouping including potential replacement words and corresponding rankings (*referring to graph in figure 5*).

15. Regarding claims 16-21, Chase further discloses the computer program of claim 11, wherein the thesaurus grouping only includes potential replacement words from the chosen lexical impact scale (*emotional categories in table 2 in col. 8-9; containing emotionally similar words that maybe potential replacement words*), wherein the thesaurus grouping only includes potential replacement words that have a positive valence with respect to the chosen lexical impact scale (*words are grouped into different emotional categories in table 2 in col. 8-9; positive emotion*), wherein the thesaurus grouping includes zero valence substitutions (*table 3 in col. 9-10 or col. 12, lines 22-35; non-emotional words*), wherein the thesaurus grouping includes out-of-scale substitutions (*table 3 in col. 9-10 or col. 12, lines 22-35; non-emotional words*), wherein the potential replacements are sorted by valence (*col. 13, lines 49-65, ranking ordered list*), wherein the potential replacements are also sorted alphabetically (*col. 13, lines 49-65, ranking ordered list*).

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16. Regarding claim 22, Chase further discloses the computer program of claim 11, wherein the thesaurus database further comprises machine readable data corresponding to homonym groupings and aural impact rankings for each homonym grouping (*referring to different categories in table 2*).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 11-13 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (USPN 6332143) in view of Chase (USPN 6389425), herein referred as Chase (425).

19. Regarding claims 11-13, Chase fails to specifically disclose the computer program of claim 10, wherein each word that exceeds the predetermined lexical impact threshold value is highlighted within the writing, wherein the words are highlighted by a variation in the color of the text words, wherein the words are highlighted by a variation in the color of the text words. However, Chase (425) teaches wherein each word that exceeds the predetermined lexical impact threshold value is highlighted within the writing (*col. 11, lines 30-50*), wherein the words are highlighted by a variation in the

color of the text words (*col. 11, lines 30-50*), wherein the words are highlighted by a variation in the color of the text words (*col. 11, lines 30-50*).

Since Chase and Chase (425) are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Chase by incorporating the teaching Chase (425) in order to provide the user with more visual effects of the analysis.

20. Regarding claims 23-24, Chase fails to specifically disclose the computer program of claim 18, wherein each word that includes undesirable aural effects is highlighted within the writing, wherein the words are highlighted by a variation in the color of the text words. However, Chase (425) teaches wherein each word that includes undesirable aural effects is highlighted within the writing (*col. 11, lines 30-50*), wherein the words are highlighted by a variation in the color of the text words (*col. 11, lines 30-50*).

Since Chase and Chase (425) are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Chase by incorporating the teaching Chase (425) in order to provide the user with more visual effects of the analysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUYEN X. VO whose telephone number is (571)272-7631. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Huyen X Vo/
Primary Examiner, Art Unit 2626

8/7/2008
